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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 10/572,853 | 02/09/2007 | Gen-Ichiro Soma | 80246(302741) | 9265 |

21874 7590 09/30/2008

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| EXAMINER | |
|---|---|
| MI, QIUWEN | |
| ART UNIT | PAPER NUMBER |
| 1655 | |
| MAIL DATE | DELIVERY MODE |
| 09/30/2008 | PAPER |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

| Office Action Summary | Application No. | Applicant(s) | |
|---|---|---|---|
| | 10/572,853 | SOMA ET AL. | |
| | Examiner | Art Unit | |
| | QIUWEN MI | 1655 | |

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)☒ Responsive to communication(s) filed on *25 April 2008*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4)☒ Claim(s) *12-14,16-22,26-29 and 33-38* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *12-14,16-22,26-29 and 33-38* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *4/25/08; 8/27/08*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

## DETAILED ACTION

Applicant's amendment in the reply filed on 7/24/08 is acknowledged, with the cancellation of Claims 1-11, 15, 23-25, and 30-32. Any rejection that is not reiterated is hereby withdrawn. Claims 12-14, 16-22, 26-29, and 33-38 are pending. **Claims 12-14, 16-22, 26-29, and 33-38 are examined on the merits.**

## Claim Rejections –35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 12-14, 16-22, 26-29, and 33-38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chotani et al (US 2003/0203454) in view of Soma et al (US 5,494,819).

This is a new rejection necessitated by the Applicant's amendment filed on 7/24/08.

Chotani et al teach a fermentative bioprocess using corn starch (edible plant that is selected from a food grain) and a microorganism known as *Pantoea citrea* (facultative anaerobic gram-negative bacterium, bacillus). According to dictionary.com, glucide means any of various organic compounds that consist of or contain a carbohydrate, thus corn starch inherently contains glucide and polysaccharide.

Since the cited reference teaches the claimed fermented plant extract and the claimed facultative anaerobic gram-negative bacterium, it is deemed that they live in a symbiotic relationship exclusively as being currently claimed.

The intended use of the composition in claims 16, and 18-22 was analyzed for patentable weight. It is deemed that the preamble 'breathes life' into the claims in that the prior art product must not be precluded for use as food, bath agent, pharmaceutical composition, for macrophage activation, or has an immunopotentiation activity. It is deemed that the composition disclosed by Nagano et al. is not precluded for carrying out the intended function of the claims. Since the cited reference teaches the claimed fermented plant extract and the claimed facultative anaerobic gram-negative bacterium, it is deemed that they live in a symbiotic relationship exclusively as being currently claimed.

Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process.

Chotani et al do not explicitly teach *Pantoea agglomerans*.

Soma et al teach a pure culture of *Pantoea agglomerans* (facultative anaerobic gram-negative bacterium, bacillus) which produces lipopolysaccharides (col 1, 7-13), and it may be used in food, drinks and feed (col 5, lines 10-15), it has excellent immunity-stimulating,

analgesic and antiwithdrawal effects show a high therapeutical range, and may be provided at a low cost and in a large amount (col 2, lines 50-55).

Therefore, it would have been *prima facie* obvious for one of ordinary skill in the art at the time the invention was made to use *Pantoea agglomerans* from Soma et al since Soma et al teach *Pantoea agglomerans* may be used in food, drinks and feed and it has excellent immunity-stimulating, analgesic and antiwithdrawal effects show a high therapeutical range, and may be provided at a low cost and in a large amount. Since both of the inventions yielded beneficial results in fermentation industry, one of ordinary skill in the art would have been motivated to make the modifications.

From the teachings of the references, it is apparent that one of the ordinary skills in the art would have had a reasonable expectation of success in producing the claimed invention.

Thus, the invention as a whole is *prima facie* obvious over the references, especially in the absence of evidence to the contrary.

Applicant's arguments have been fully considered but they are not persuasive, and therefore the claims remain rejected.

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**Conclusion**

No claim is allowed.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Qiuwen Mi whose telephone number is 571-272-5984. The examiner can normally be reached on 8 to 5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terry McKelvey can be reached on 571-272-0775. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

QM

/Michele Flood/

Primary Examiner, Art Unit 1655